

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKEHI HAYAKAWA,
KISHIO SHIBATO
and YASUHIRO MONMA

Appeal No. 2001-0825
Application No. 08/952,566

ON BRIEF

Before JEFFREY SMITH, PAWLIKOWSKI and POTEATE, **Administrative
Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 and 4, all of the claims on appeal.

The subject matter on appeal is representative by claims 1 and 4, set forth below:

1. A thermoset paint composition, comprising:

(a) from 20 to 70% by weight of a fluorine containing copolymer comprising the result of copolymerizing

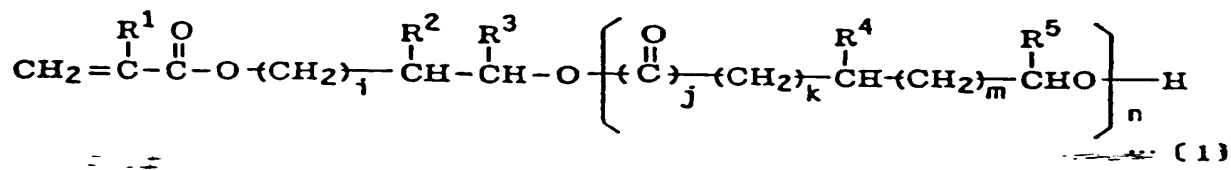
at least one fluoro-olefin monomer,

at least 10% by weight of one or more hydroxy group containing vinyl monomer having at least four atoms between a vinyl group and a hydroxy group, and a terminal hydroxy group, the percent by weight based on the total weight of copolymer (a), and

one or more other vinyl monomers,

the fluorine containing copolymer (a) having a solubility parameter from 9.0 to 10.5 and a hydroxy group value from 60 to 150 mgKOH/g,

(b) from 20-70% by weight of a vinyl (co)polymer comprising the result of copolymerizing at least one vinyl monomer, said at least one vinyl monomer comprising at least 10% by weight of one or more monomers represented by the general formula 1



wherein R^1 to R^5 each independently represent H or methyl group, i is 0-2, j is 0 or 1, k is 0-3, m is 0-3 and n is 0-10,

the vinyl (co)polymer [sic] (b) having a solubility parameter from 9.0 to 10.5 and a hydroxy group value from 60 to 150 mgKOH/g,

(c) from 5 to 40% by weight of alkyl etherified melamine resin, and

(d) from 2 to 40% by weight of blocked polyisocyanate compound, wherein all percents by weight are based on the total weight of the resin components (a) to (d) the thermoset paint composition providing a paint film having a glass transition temperature after hardening of at least 50°C.

4. The thermoset paint composition of claim 1 which is a topcoat.

The examiner relies on the following references as evidence of unpatentability:

Sawada et al. (Sawada)	5,100,962	Mar. 31, 1992
Mohri et al. (Mohri)	5,169,915	Dec. 08, 1992
Shibato (International Patent Publication)	WO 94/09916	May 11, 1994

Claims 1 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shibato in view of Sawada or Mohri.

OPINION

We have carefully considered both the appellants' position and the examiner's position in connection with the issues on appeal. Upon our review, we reverse the aforementioned rejection for the following reasons.

The examiner's position is that Shibato teaches appellants' claimed components (b), (c), and (d), but does not teach claimed component (a). The examiner relies upon Sawada or Mohri for teaching the use of fluorine containing copolymers in a coating composition. The examiner concludes that it would be obvious to one of ordinary skill in the art to incorporate the fluorine containing resin of Sawada or Mohri in the composition of Shibato for improved properties of the coating. (answer, pages 3-6).

We note that the initial burden of presenting a prima facie case obviousness rest on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We determine that the examiner's rejection does not establish a prima facie case of obviousness for the following reasons.

Component (a) of claim 1 requires the following:

(a) from 20 to 70% by weight of a fluorine containing copolymer comprising the result of copolymerizing

at least one fluoro-olefin monomer,
at least 10% by weight of one or more hydroxy group containing vinyl monomer having at least four atoms between a vinyl group and a hydroxy group, and a terminal hydroxy group, the percent by weight based on the total weight of copolymer (a), and
one or more other vinyl monomers,

the fluorine containing copolymer (a) having a solubility parameter from 9.0 to 10.5 and a hydroxy group value from 620 to 150 mgKOH/g

Here, the examiner refers to the abstract and columns 2-5 of Sawada, and also states that copolymer (A) disclosed in Sawada, in column 8 beginning at line 14, has a solubility parameter value of 9.8, which falls within the values claimed by appellants. (answer, page 4).

However, we find that the examiner's position does not explain how the fluorine containing copolymer disclosed in Sawada satisfies the requirements of appellants' claimed component (a), reproduced above. Although we observe that the fluorine containing copolymer in column 8, beginning at line 15, of Sawada has a hydroxyl value of 52 and solubility parameter value of 8.9, the examiner does not explain how this copolymer is a result of copolymerizing (1) at least one fluoro olefin

monomer, (2) the particularly claimed vinyl monomer, and (3) one or more other vinyl monomers. Hence, the examiner's ground of rejection does not explain how the requirements of component (a) of appellants' claim 1 is met in this regard. Nor does the examiner's response (beginning of page 4 on the answer) to appellants' arguments on this issue explain how such requirements are met.

Likewise, the examiner does not explain how the fluorine containing copolymer of Mohri meets these aspects of component (a) of appellants' claim 1.

We note that the burden is on the examiner **to identify concrete evidence in the record to support his conclusion** that it would have been obvious to modify the teachings of the cited references to achieve the claimed invention [emphasis added]. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). In the present case, the examiner has simply failed to meet this burden.

We therefore determine the examiner has not set forth a prima facie case of obviousness.

Appeal No. 2001-0825
Application No. 08/952,566

We reverse the rejection.

REVERSED

JEFFREY T. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
)	APPEALS AND
BEVERLY A. PAWLIKOWSKI)	INTERFERENCES
Administrative Patent Judge)	
)	
)	
)	
)	
LINDA R. POTEATE)	
Administrative Patent Judge)	

BAP/sld

Appeal No. 2001-0825
Application No. 08/952,566

BASF CORPORATION
PATENT DEPARTMENT
26701 TELEGRAPH ROAD
SOUTHFIELD, MI 48034-2442